

7. (Original) The composition in accordance with Claim 1 where a nonionic surfactant is also present.
8. (Original) The composition in accordance with Claim 1 wherein the particles bear the oily conditioning agent within or upon the surface of the particle.
9. (Original) The composition in accordance with Claim 1 wherein oily conditioning agents are selected from the group consisting of vitamins, provitamins, emollients, moisturizers, silicones, vegetable oils and mineral oils.
10. (Original) The composition in accordance with Claim 1 wherein the particles have a density in the range of about 0.92 to about 1.05 gm/cm³.
11. (Original) The composition in accordance with Claim 1 wherein the particles have an average diameter size of from about 800 to about 1800 microns.
12. (Original) The composition in accordance with Claim 3 wherein the betaine is cocoamidopropyl betaine.
13. (Original) The composition in accordance with Claim 1 comprising 5 to about 20 wt. % of the anionic surfactant.
14. (Original) The composition in accordance with Claim 1 comprising 7 to about 13 wt. % of the anionic surfactant.

RESPONSE

In the Office Action of May 5, 2004, the Examiner rejects Claims 1-14 under 35 USC 103(a) on the basis of USP 5,681,801 to Zocchi ("ZOCCHI") in view of USP 5,980,877 to Baravetto ("BARAVETTO") or USP 5,948,739 to Inman ("INMAN"). These rejections are respectfully traversed for the reasons described herein.

ZOCCHI describes a clear system with a single gum component. The only reason ZOCCHI maintains clarity is because the conditioning system is in the form of distinct beads in the suspension. There is no teaching of how to use a dual gum system and maintain the clarity and smooth flow properties of the present invention. Further, the

Examiner acknowledges that ZOCCHI does not teach a personal cleansing composition containing hydroxypropyl guar gum, an anionic surfactant, an amphoteric surfactant, a suspending material mixture comprised of xanthan gum and guar gum, and particles bearing a conditioning agent suspended in an aqueous phase in the specific proportions as recited by the instant claims. Neither BARAVETTO nor INMAN are discussed by the Examiner and further explanation is requested if the Examiner wishes to maintain any rejection based on these latter two references.

The Examiner discusses USP 5,576,279 to Pyles ("PYLES"). This reference is not relevant to the present invention because (a) it is not a clear composition and (b) it contains cationic materials which are not compatible with the present invention.

The Examiner discusses USP 5,104,646 to Bolich et al ("BOLICH"). This reference is not relevant to the present invention because it is not a clear composition.

Thus, there is no teaching either alone or in combination of the references listed above of how to achieve the clear composition of the present invention with a dual gum system.

It is respectfully submitted that the Examiner has not shown any motivation to combine the references discussed above, and has certainly not shown how one could derive the invention as now claimed from such references, especially with the very specific limitations included in the Claims. The Examiner appears to take the position that any patent describing a cleansing system can be combined with any other patent that describes a cleansing system regardless of issues such as clarity and compatibility of the ingredients. This is not the standard to be applied.

Applicants submit that the rejections discussed above are nothing more than a hindsight manipulation of the references in an attempt to create the compositions of the Claims on appeal and meet the limitations described therein. Indeed, the manipulation to which the Examiner resorts is not an appropriate application of the references under U.S. patent law. Even with the benefit of hindsight, however, one cannot manipulate the teachings of the cited references so as to formulate a composition which is consistent with the teachings of the reference and which could meet the limitations of applicant's claims. Such reasoning is also inappropriate under the standard of 35 USC 103: In Ex

parte Chicago Rawhide Manufacturing Co., 226 USPQ 438 (PTO Bd. App. 1984), the following was stated:

The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable. 226 USPQ at 440

The CAFC has spoken consistently on this issue. For example, in In re Jones, 21 USPQ 2d 1941 (Fed. Cir. 1992) the following was stated:

Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the ... art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed ...salt. 21 USPQ 2d at 1944.

Also in In Re Rouffet the CAFC has held that the claimed invention may not be used by the Examiner as a blueprint for piecing together elements in the prior art to fashion a rejection of the claims:

As this court has stated, "virtually all [inventions] are combinations of old elements" [citations omitted]...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability."

47 USPQ 2d at 1457, citing Sensonics, Inc. v. Aerosonic Corp., 81

F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

In view of the comments submitted with this Response, it is believed that the case is in a form ready for allowance. Thus, withdrawal of the pending rejections is requested, and an early Notice of Allowability is earnestly solicited.

Respectfully submitted,



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